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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,769	07/31/2003	Steven Sholtis	CA7035172003	3084
23639	7590	02/03/2006	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067			MIZRAHI, DIANE D	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/632,769

Applicant(s)

SHOLTIS ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

III. DETAILED ACTION

Claims 1-55 are presented for examination and are pending.

Drawings

The Examiner contends that the drawings submitted on July 31, 2003 are acceptable for examination proceedings. These are informal drawings.

Claim Objections

Claim 49 is objected to because of the following informalities: Claim 49 depends on Claim 49. Examiner is unclear as to what Applicant intended for claim 49 to depend on. Appropriate correction is required.

Claim Rejections - 35 USC , 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-55 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility  
<[http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101\\_20051026.pdf](http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf)> )

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 Wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work Gottschalk v. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker v. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of a data structure is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir.

1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Therefore, Examiner believes that the above listed claims are nonstatutory.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28, 36, 37, 40-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to what applicant means by "and/or". For the sake of examination, "and/or" will be interpreted as "or". All claims should be reviewed checked for clarification. Further clarification and explanation is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the

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invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Copperman et al. (U.S. Patent No. 6,711,585 B1 and Copperman hereinafter).

Regarding Claim 1, and 54-55, Copperman teaches of implementing and using a federated system, the method comprising: defining a plurality of data sources on a node, each data source being associated with a taxonomy (col 6, lines 46-63); establishing a taxonomy view at the node (col 24, lines 13-78); creating one or more mappings between the taxonomy view at the node and the taxonomy of at least one of the plurality of data sources (col 7, lines 49-67); and accessing the plurality of data sources via the taxonomy view (col 24, lines 13-28).

Regarding Claim 2, Copperman teaches wherein defining a plurality of data sources on a node comprises: selecting one or more data resources to be used in each data source; specifying one or more connection parameters to each data resource, and making available one or more objects from each data resource, the taxonomy of each data source comprising the one or more

available data resource objects in the data source (col 8, lines 52-63) (col 12, Table 2).

Regarding Claim 3, Copperman teaches wherein each data resource is of a type and at least one of the plurality of data sources comprises data resources of different types (col 8, lines 52-63) (col 12, Table 2).

Regarding Claim 4, Copperman teaches wherein a type of data resource is a text file (col 12, lines 38-61).

Regarding Claim 5, Copperman teaches creating one or more mappings between the taxonomy view of the node and the taxonomy of at least one of the plurality of data sources comprises: determining whether each available data resource object in the taxonomy of the at least one data source matches one or more objects in the taxonomy view of the node; creating at least one new object in the taxonomy view of the node for each available data resource object in the taxonomy of the at least one data source without a matching taxonomy view object; and mapping each available data resource object in the taxonomy of the at least one data source to the one or more objects in the taxonomy view of the node matches the available data resource object (col 14, lines 47-67 to col 15, lines 1-23).

Regarding Claim 6, Copperman teaches wherein an available data resource object matches a taxonomy view object when the two objects are identical (Figure 6).

Regarding Claim 7, Copperman teaches wherein an object is a category, a property, or an attribute (col 28, lines 36-67 to col 29, lines 1-7).

Regarding Claim 8, Copperman teaches wherein establishing a taxonomy view for the node comprises: taking a snapshot of the taxonomy of at least one of the plurality of data sources defined on the node (i.e. reads on identical) (col 23, lines 38-67 to col 24, lines 1-12).

Regarding Claim 9, Copperman teaches taxonomy of at least one of the plurality of data sources is different from the taxonomy of at least one other data source (Figure 12).

Regarding Claim 10, Copperman teaches plurality of data sources defined on the node resides on the node (Figure 12).

Regarding Claim 11, Copperman teaches wherein at least one of the one or more mappings between the taxonomy view of the node and the taxonomy of the at least one data source is created automatically (col 12, lines 38-61).

Regarding Claim 12, Copperman teaches wherein each object in the taxonomy view is unique (col 24, lines 39-67 to col 25, lines 1-65).



Regarding Claims 13-53, these claims are similar in scope to the rejected claims above and are therefore rejected as set forth above.

**Other Prior Art Made of Record**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

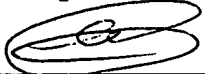
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



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Diane Mizrahi  
Primary Patent Examiner  
Technology Center 2100

January 25, 2005